REMARKS

Reconsideration and allowance in view of the following remarks are respectfully requested.

Claims 1-23 remain pending in the present application.

Claims 1-23 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of copending Application No. 10/384,329 ("the '329 application"). Applicant respectfully traverses this rejection for the reasons presented below.

In determining whether a nonstatutory basis exists for a double patenting rejection, the first question to be asked is - does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the patent? M.P.E.P. § 804 (II)(B)(1). Please note that this section of the M.P.E.P addresses the more common double patenting situation, where the claims of an application are rejected as obviousness type double patenting over claims in an issued patent. However, the reasoning set forth in this section applies equally to the present provisional double patenting rejection, where the claims in the present application are rejected as obviousness type double patenting over claims in a pending application, namely the '329 application.

As explained in this section of the M.P.E.P., a double patenting rejection of the obviousness-type is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103" except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 U.S.P.Q. 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 U.S.P.Q.2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 U.S.P.Q. 645 (Fed. Cir. 1985).

Because the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966), that are applied for

establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis. M.P.E.P. § 804 (II)(B)(1). These factual inquiries are summarized as follows:

(A) Determine the scope and content of a patent claim relative to a claim in the application at issue;

(B) Determine the differences between the scope and content of the patent claim as determined in (A) and the claim in the application at issue;

(C) Determine the level of ordinary skill in the pertinent art; and

(D) Evaluate any objective indicia of nonobviousness.

The conclusion of obviousness-type double patenting is made in light of these factual determinations.

Applicant submits that the Examiner has not used the proper standard in determining whether the claims in the present application constitute obviousness-type double patenting over claims 1-26 in the '329 application. In rejecting claims 1-23 of the present application as obviousness-type double patenting over claims 1-26 in the '329 application the Examiner states as follows: "[although] the conflicting claims are not identical, they are not patentably distinct from each other because both devices would define a gas sampling assembly with a hydrophobic filter and a sample collection portion that utilizes radiation measurements to determine gas concentration of a sample contained therein." (emphasis added). This reasoning bears no relationship to the obvious-type double patenting analysis set forth in case law and set forth in the M.P.E.P. § 804 (II)(B)(1). The Examiner has not determined the scope and content of a patent claim relative to a claim in the application at issue and the Examiner has not determined the differences therebetween. Nor has the Examiner explained how or why these differences are obvious to one of ordinary skill in the art.

The M.P.E.P. § 804 (II)(B)(1) further states that any obviousness-type double patenting rejection should make clear:

(A) the differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue would have been an obvious variation of the invention defined in a claim in the patent.

When considering whether the invention defined in a claim of an application would have been an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1279, 23 USPQ2d 1839, 1846 (Fed. Cir. 1992). Again, by making the blanket statement that both sets of claims cover a gas sampling assembly with a hydrophobic filter, the Examiner has not followed the proper analysis set forth in the M.P.E.P. in order to determine whether the claims in a later filed application constitute provisional obviousness-type double patenting of the claims in an early filed application.

Under a proper analysis, the Examiner would have reviewed claim 1 in the '329 application for example, and compared this claim to claim 1 in the present application. Claim 1, currently on file in the '329 application is reproduced below:

> 1. A sample cell for use in sidestream respiratory gas monitoring, comprising:
>
> (a) a sample cell body having a gas flow path defined therethrough, wherein the sample cell body is generally rectangular and includes:
>
> (1) a first side defined in a first plane,
>
> (2) a second side opposite the first side and defined in a second plane that is generally parallel to the first plane, wherein the gas flow path is defined from the first side to the second side of the sample cell body, and wherein a longitudinal axis of the sample cell body is also defined between the first side and the second side in a direction that is generally perpendicular to the first plane and the second plane,
>
> (3) an inlet port coupled to the first side of the sample cell body, wherein the inlet port has an outside diameter that is less than a length or a width of the first side of the sample cell body,
>
> (4) an outlet port coupled to the second side of the sample cell body, wherein the outlet port has an outside diameter that is less than a length or a width of the second side of the sample cell body, and
>
> (5) a first wall extending between the first side and the second side of the sample cell body;
>
> (b) a flexible protrusion extending from the sample cell body and configured to cooperate with a corresponding feature of a sidestream gas

measurement assembly that at least partially receives the sample cell to maintain the sample cell body in an engaged relation with the sidestream gas measurement assembly;

(c) a sample chamber defined in the sample cell body along the gas flow path for receiving a respiratory sample from a patient; and

(d) a first window defined in the first wall of the sample cell body and forming at least a portion of a boundary of the sample chamber, wherein the first window facilitates analysis of an amount of a gas or vaporized material disposed in the sample chamber responsive to the sample cell and the sidestream gas measurement assembly being placed in an assembled relationship.

Comparing claim 1 of the '329 application to claim 1 of the present application, for example, reveals many distinctions. For example, claim 1 of the '329 application indicates that the first side of the sample cell is defined in a first plane and the second side opposite the first side and defined in a second plane that is generally parallel to the first plane. There is no similar language in claim 1 of the present application. Claim 1 of the '329 application also recites that the longitudinal axis of the sample cell body is also defined between the first side and the second side in a direction that is generally perpendicular to the first plane and the second plane. Again, there is no such language in the description of the sample cell recited in claim 1 of the present application. Claim 1 of the '329 application recites that the inlet port coupled to the first side of the sample cell body has an outside diameter that is less than a length or a width of the first side of the sample cell body. This feature is also not recited in claim 1 of the present application. Claim 1 of the '329 application further recites a flexible protrusion extending from the sample cell body and configured to cooperate with a corresponding feature of a sidestream gas measurement assembly that at least partially receives the sample cell to maintain the sample cell body in an engaged relation with the sidestream gas measurement assembly. No such feature is recited in claim 1 of the present application.

There are also features recited in claim 1 of the present application that are not recited in the claims of the '329 application. For example, claim 1 recites a gas sampling assembly that includes a filter portion and a sample collection portion in which the filter portion and the sample collection portion define a unitary assembly, with the housing portion of the filter being integral with the body section of the sample collection chamber. The filter portion

includes at least one filter element operatively coupled to the housing to filter materials/fluids from the gas passing to the sample collection portion. Applicant submits that these features are not found in the claims currently pending in the '329 application. Applicant notes that claims 4 and 17 of the '329 application recite a filter, but these claims do not indicate that the filter is coupled to the sample cell as a unitary housing, for example.

Once the differences between the claims of the '329 application and the claims of the present invention are determined, the next step is to determine whether one of ordinary skill in the art would conclude that the invention defined in the claim 1 of the present application would have been an obvious variation of the invention defined in a claim in the patent. To this end the Examiner would be expected to identify a teaching or suggestion that would motivate one skilled in the art to modify the claims in the '329 application to render obvious the claims in the present application. No such reference or explanation has been offered by the Examiner. Thus, the obviousness type double patenting rejection has not been properly made.

Applicant also respectfully notes that in stating that claims in the present application and the claims in the '329 application are "not patentably distinct from each other because both devices would define a gas sampling assembly with a hydrophobic filter and a sample collection portion that utilizes radiation measurements to determine gas concentration of a sample contained therein", the Examiner is improperly over-simplifying the claims and ignoring the expressly recited claim language. As noted above, there are many other features recited in both sets of claims that define the invention of each patent application. It is an impermissible oversimplification to simply ignore the further features and to add elements that are not present. For example, no claim in the '329 application defines the filter as being a hydrophobic filter element. This was simply added by the Examiner without explanation.

For the reasons presented above, applicant respectfully submits that independent claims 1 and 12 do not constitute obvious-type double patenting of the claims currently pending in the '329 application. In addition, claims 2-11 and 13-23 also do not constitute obvious-type double patenting of the claims currently pending in the '329 application due to their dependency from independent claims 1 or 12. Accordingly, applicant respectfully requests that the above rejection of claims 1-23 be withdrawn.

This response is being filed within the three-month statutory response period which expires on November 24, 2005. In addition, no additional claim fees are believed to be required as a result of the above amendments to the claims. Nevertheless, the Commission is authorized to charge the any fee required under 37 C.F.R. §§ 1.16 or 1.17 to deposit account no. 50-0558.

All rejections have been addressed. It is respectfully submitted that the present application is in condition for allowance and a Notice to the effect is earnestly solicited.

Respectfully submitted,

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